

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

In the present Supplemental Amendment, claim 1 has been amended, and claim 25 has been canceled, wherein claims 2, 3, 15-18, 20 and 21 were previously canceled, without prejudice or disclaimer of the subject. Claims 22-24 are withdrawn from consideration. This makes claims 1, 4-14, 19 and 22-24 as pending in the present application.

No new matter has been added with the amendment to claim 1. For the recitation of “not less than 15 mmol/kg”, Applicants note paragraphs [0063] (page 33) and [0103] (page 48) of the present specification. For the alicyclic amino group recitation, see paragraph [0033] (page 20). Finally, for the terminal amino group recitation, see paragraph [0064] (pages 33-34) of the specification.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. §§ 102(b) and 103(a)

Claim 20 stands rejected under 35 U.S.C. § 102(b) as being anticipated by **Oenbrink** (U.S. Patent No. 6,538,073) (see Final Office Action, page 2).

Further, claims 1-10, 12, 14, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Matsumoto** (U.S. Patent No. 4,410,595) in view of **Oenbrink** (U.S. Patent No. 6,538,073) (Final Office Action, pages 3-4).

Also, claims 1-14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over **Matsumoto** in view of **Goetz** (U.S. Patent No. 5,254,620) and **Oenbrink** (Final Office Action, pages 5-7).

Applicants respectfully traverse all rejections.

First, as claim 20 has been canceled, the first rejection has been rendered moot.

Second, regarding the other two § 103(a) rejections, Applicants respectfully maintain their position as stated in the previous response dated June 9, 2010. Still, in response to Applicants' previous arguments, the Examiner states in the latest Advisory Action (dated June 24, 2010) at page 2 (in response to the argument that the Oenbrink polyamine is a co-monomer):

Applicant states "the graft copolymer [of Oenbrink] has not yet contained the free polyamine" and argues the polyamine is "only a co-monomer" (p9). The examiner notes examined claim 1 requires only "a thermoplastic resin (Ib) compris[ing]...an amino group-containing compound." Oenbrink's copolymer contains an amino group-containing compound, i.e., polyamine, and therefore meets the requirements of the claim.

However, Applicants respectfully refer the Examiner to claim 1 as shown herein. Oenbrink is excluded from the scope of the present invention (see, e.g., the language at the end of claim 1).

Additionally, by reciting the terminal amino group for resin (Ib-1) for the present invention, even if "Oenbrink" were to be combined with "Matsumoto" (which Applicants still submit is improper), the skilled artisan would never deduce or realize a resin composition (Ib-1) having an alicyclic amino group as the terminal amino group as instantly claimed. This is

because Oenbrink merely discloses the alicyclic monomers as only an example of regulators.

Thus, the present invention would not be achieved.

Also, in response to Applicants' previous arguments of unexpected results, the Examiner states in the Advisory Action (at page 3):

Applicant states there are unexpected advantages to the present invention, in particular the bond strength between the non-urethane resin and a thermoplastic polyurethane resin member (p10). Applicant also points to the Examples in the specification as evidence. The examiner does not find these arguments persuasive, however, for the following reasons:

- 1) Oenbrink teaches polyamide graft copolymers falling under the scope of the present claims, and further teaches they are suitable as adhesives.
- 2) The data, i.e., the Examples, are not persuasive because they are not commensurate in scope with the present claims. The Examples disclose specific polymers having specific concentrations while the present claim 1 requires only a non-urethane thermoplastic resin comprising a polyamide having an alicyclic ring, or an amino-group containing compound.
- 3) The data are not persuasive also because Example 6, which appears to be a comparative example though not identified as such, having an amino group concentration of 4 mmol/kg—less than the claimed minimum of 10 mmol/kg—adheres more strongly to polyether polyurethane compared to Example 4 and adheres nearly the same amount as Example 5 (see Table 1). Therefore, the results seem dependent on the identity of the polyurethane resin member, contradicting Applicant's statements.

In response, with the instant claim amendments, the present invention is directed to at least the “the non-urethane thermoplastic resin (Ib) [having] an amino group in a concentration of not less than 15 mmol/kg” and “in the resin composition (Ib-1), the resin is a polyamide-series resin which comprises a polyamide component having an alicyclic ring and contains a terminal amino group in a concentration of not less than 15 mmol/kg, wherein a part of or all the terminal amino group is an alicyclic amino group”. Thus, reconsideration is respectfully requested as Applicants believe that the experimental data is commensurate in scope with the claimed invention. Applicants request that all arguments and evidence be considered anew. *See In re Eli*

Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990) (citing *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984)).

Also regarding point 3) at page 3 of the Advisory Action, the strong adhesion in Example 6 is realized by a polyether segment contained in each of the polyamide resin and the thermoplastic polyurethane-series resin, as evidenced by the low adhesion in the polyester polyurethane. On the other hand, in Examples 4 and 5, both the polyether polyurethane and the polyester polyurethane strongly adhere to the polyamide resin (composition). That is, the strong adhesion in Examples 4 and 5 is because of a combination of a polyamide component having an alicyclic ring or an alicyclic amino group as the terminal amino group with a specific concentration of an amino group, and never depends on the identity of the thermoplastic polyurethane-series resin. Thus, unexpected results exist for the present invention.

Regarding the resin composition (Ib-2) of claim 1, Applicants maintain for reasons of record that one of ordinary skill in the art would not have the proper reason or rationale (or motivation) to combine Goetz with Matsumoto.¹

Based on the present amendments and all evidence and arguments to date, reconsideration and withdrawal of all rejections are respectfully requested.

¹ In point 1) at page 3 of the Advisory Action, the Examiner states “Oenbrink...teaches suitable as adhesive,” but does not refer to the Goetz reference.

Issues under 35 U.S.C. § 112, Second Paragraph

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as stated in the Final Office Action, pages 7-8. However, it is believed that this rejection has been overcome as indicated in the Advisory Action, page 3.

Information Disclosure Statement

Applicants note an Information Disclosure Statement (IDS) was filed on June 24, 2010. Thus, consideration of the cited references and a returned, initialed copy of the IDS are respectfully requested.

Conclusion

Based on the arguments, amendments and evidence to date, favorable action on the merits of all of the claims of the present application is respectfully submitted.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez, Registration No. 48501 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No.: 10/574,265

Art Unit 1787

Supplemental Reply to Office Action of March 09, 2010

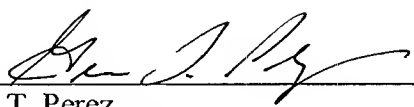
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If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: August 20, 2010

Respectfully submitted,

By 

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